

ESTTA Tracking number: **ESTTA598849**

Filing date: **04/16/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	University of South Carolina
Granted to Date of previous extension	04/16/2014
Address	109 Osborne Administration Building Columbia, SC 29308 UNITED STATES
Attorney information	John C. McElwaine Nelson Mullins Riley & Scarborough LLP 100 North Tryon Street 42nd Floor, IP Department Charlotte, NC 28202 UNITED STATES ip@nelsonmullins.com, john.mcelwaine@nelsonmullins.com Phone:843-720-4302

Applicant Information

Application No	85830525	Publication date	12/17/2013
Opposition Filing Date	04/16/2014	Opposition Period Ends	04/16/2014
Applicant	Palmetto Promotions LLC 1314 Rosewood Drive Columbia, SC 29201 SEYCHELLES		

Goods/Services Affected by Opposition


Class 025. First Use: 2012/12/15 First Use In Commerce: 2012/12/15
All goods and services in the class are opposed, namely: (Based on Use in Commerce) Baseball caps; Caps; Golf caps; T-shirts; (Based on Intent to Use) Cap visors; Golf shirts; Hooded sweat shirts; Knitted caps; Long-sleeved shirts; Moisture-wicking sports shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; Wind shirts

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2673775	Application Date	08/14/2000
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Registration Date	01/14/2003	Foreign Priority Date	NONE
Word Mark	C		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 metal key chains, metal license plates and metal money clips</p> <p>Class 009. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Mouse pads, magnets, [telephones, computer screensaver software,] football helmets</p> <p>Class 014. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Jewelry; namely, earrings, charms, necklaces and pendants, tie tacks, cuff links, clocks, and watches</p> <p>Class 016. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Paper goods and printed matter; namely,stickers, bumper stickers, decals, decalcomanias, [printed paper signs,] bankchecks, calendars, notebooks, spiral notebooks; pens and pencils</p> <p>Class 018. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Backpacks, [fanny packs,] tote bags, luggage, umbrellas, wallets</p> <p>Class 020. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Bean bag chairs, stadium seat cushions,and non-metal money clips</p> <p>Class 021. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Sport bottles sold empty, coasters, insulating sleeve holders for beverage cans, glass drinking glasses, beer mugs, shot glasses, earthenware mugs, and wastepaper baskets</p> <p>Class 024. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Towels, bed blankets, cloth pennants, cloth flags, golf towels, and oven mitts</p> <p>Class 025. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Clothing; namely, bandannas, t-shirts, shorts, sweaters, rain coats, sweatshirts, sweatpants, golf shirts, jackets, baseball hats, visors, socks, shoes university athletic team jerseys, belts and suspenders</p> <p>Class 028. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Golf balls, golf bags, golf tees, divotrepair tools, footballs, basketballs, [soccer balls, baseballs,] decorative wind socks, board games, flying discs, stuffed toy animals, [and yo-yos]</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Common Law trademark rights in the design of a stylized letter "C".		

Goods/Services	Exhibitions of ntercollegiate athletics team contests and on related uniforms and clothing.
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Attachments	76108953#TMSN.gif(bytes) NOO.pdf(1238222 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/John C. McElwaine/
Name	John C. McElwaine
Date	04/16/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of South Carolina,)	Opposition No.: _____
)	
Opposer,)	Serial No.: 85830525
)	
vs.)	Mark: C (stylized)
)	
Palmetto Promotions, LLC)	Published: 12/17/2013
Applicant.)	
)	

NOTICE OF OPPOSITION

University of South Carolina (“USC” or “the University”), an agency of the State of South Carolina with an address of 109 Osborne Administration Building Columbia, South Carolina 29208, hereby opposes the application of Palmetto Promotions, LLC., (“Applicant”) for the registration of C (stylized) as a trademark in International Class 25 for "(Based on Use in Commerce) Baseball caps; Caps; Golf caps; T-shirts; (Based on Intent to Use) Cap visors; Golf shirts; Hooded sweat shirts; Knitted caps; Long-sleeved shirts; Moisture-wicking sports shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; Wind shirts," Serial No.: 85830525, filed January 23, 2013, and published in the Official Gazette of December 17, 2013.

USC states the following grounds in support of its opposition:

1. The University of South Carolina is the flagship public university in the State of South Carolina.
2. Since at least as early as 1909, USC adopted and has used substantially continuously a stylized letter "C" in connection with its intercollegiate athletics teams and on related uniforms and clothing.

3. USC is the owner of U.S. Registration No. 2,673,775, issued on January 14, 2003, for the mark C (and Design) used in connection with the following:

Metal key chains, metal license plates and metal money clips, in International Class 6;

Mouse pads, magnets, football helmets, in International Class 9;

Jewelry; namely, earrings, charms, necklaces and pendants, tie tacks, cuff links, clocks, and watches, in International Class 14;

Paper goods and printed matter; namely, stickers, bumper stickers, decals, decalcomanias, bank checks, calendars, notebooks, spiral notebooks; pens and pencils, in International Class 16;

Backpacks, tote bags, luggage, umbrellas, wallets, in International Class 18;

Bean bag chairs, stadium seat cushions, and non-metal money clips, in International Class 20;

Sport bottles sold empty, coasters, insulating sleeve holders for beverage cans, glass drinking glasses, beer mugs, shot glasses, earthenware mugs, and wastepaper baskets, in International Class 21;

Towels, bed blankets, cloth pennants, cloth flags, golf towels, and oven mitts, in International Class 24;

Clothing; namely, bandannas, t-shirts, shorts, sweaters, rain coats, sweatshirts, sweatpants, golf shirts, jackets, baseball hats, visors, socks, shoes university athletic team jerseys, belts and suspenders, in International Class 25;

Golf balls, golf bags, golf tees, divot repair tools, footballs, basketballs, decorative wind socks, board games, flying discs, stuffed toy animals, in International Class 28.

See Exhibit A containing TSDR Record Printout.

4. USC's use of a stylized letter "C", including the stylized "C" in U.S. Reg. No. 2,673,775 (the "USC Block C Mark"), long precedes the filing date of the above-referenced application. Thus, there is no issue as to USC's senior priority.

5. USC has developed and currently possesses substantial goodwill in the USC Block C Mark.

6. Continuously, and since long before any use of the mark in the above-referenced application, USC has used the color combination of garnet and black to identify its intercollegiate athletic teams and to distinguish them from those established by others by, among other things, displaying and using this color combination in connection with its merchandising and marketing materials.

7. As a result of the significant use, publicity and advertising by USC of its common law trademark in the color combination of garnet and black, said mark has developed and now has acquired secondary and distinctive meaning. The colors garnet and black have come to indicate and represent USC, its intercollegiate athletic teams, educational services and its related products.

8. The USC Block C Mark is a trademark which is famous on a nationwide basis, is uniquely, distinctively, and exclusively associated with USC, its athletic teams and related merchandise, and points unmistakably to USC, its intercollegiate athletic teams, educational services and its related products.

9. Applicant seeks to register and intends to use the stylized letter "C" in Serial No.: 85830525 in connection with products that are highly related to products sold by USC's authorized licensees.

10. Applicant is actually using in commerce the stylized letter "C" in Serial No.: 85830525 in connection with products that are sold using the colors garnet and black.

11. The markets for USC's products and services and Applicant's goods are so similar as to cause a likelihood of confusion when sold or rendered under the marks in issue.

12. Applicant's applied-for trademark so resembles USC's registered and common law marks when used in connection with Applicant's goods, as to be likely to cause confusion or to cause mistake or to deceive, in violation of Section 2(d) of the Lanham Act, and/or as to falsely suggest a connection with the University in violation of Section 2(a) of the Lanham Act. Furthermore, consumers seeing advertisements or visiting the parties' web pages where the products are advertised are likely to be confused into believing that Applicant's goods originated with, were sponsored by, or were connected with, USC.

13. USC will be damaged by the registration of Applicant's mark, for the reasons set forth above, and such registration may interfere with USC's ability to conduct or expand its business. Furthermore, since confusion in the trade is likely, consumers may purchase the Applicant's products believing them to be USC's. Such confusion will damage the University because of lost sales and injury to its goodwill and reputation.

14. USC will also be damaged because, if the Applicant is granted the registration applied for herein, it would thereby obtain at least a prima facie exclusive right to use the mark.

15. USC is further damaged because the registration by Applicant of the applied-for C (stylized) will dilute the distinctive quality of the USC Block C Mark, which became famous prior to the Applicant's first use date, and will result in injury to the goodwill and reputation that USC has acquired with respect to its trademark.

WHEREFORE, USC believes that it will be damaged by said registration and prays that this opposition be sustained.

[SIGNATURE ON NEXT PAGE]

NELSON MULLINS RILEY & SCARBOROUGH, L.L.P.

By: 

John C. McElwaine
Liberty Building, Suite 600
151 Meeting Street
Post Office Box 1806 (29402)
Charleston, SC 29401
(843) 720-4302

Attorneys for University of South Carolina

Charleston, South Carolina
April 16, 2014

Exhibit A

STATUS DOCUMENTS

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Generated on: This page was generated by TSDR on 2014-04-16 09:47:37 EDT

Mark: C



US Serial Number: 76108953

Application Filing Date: Aug. 14, 2012

US Registration Number: 2673775

Registration Date: Jan. 14, 2012

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Sep. 12, 2012

Publication Date: Oct. 22, 2002

Mark Information

Mark Literal Elements: C

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 03.15.08 - Cranes; Flamingos; Herons; Ibis; Storks, flamingos, heron and other long-legged waterfowl;
03.15.24 - Stylized birds and bats

Related Properties Information

Claimed Ownership of US [2065288](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability;
- Asterisks *..* identify additional (new) wording in the goods/services.

For: metal key chains, metal license plates and metal money clips

International Class(es): 006 - Primary Class

U.S Class(es): 002, 012, 014

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Mouse pads, magnets, [telephones, computer screensaver software,] football helmets

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 024

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Jewelry; namely, earrings, charms, necklaces and pendants, tie tacks, cuff links, clocks, and watches

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Paper goods and printed matter; namely, stickers, bumper stickers, decals, decalcomanias, [postcards,] calendars, notebooks, spiral notebooks; pens and pencils

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 006

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Backpacks, [fanny packs,] tote bags, luggage, umbrellas, wallets

International Class(es): 018 - Primary Class

U.S Class(es): 001, 002, 003

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Bean bag chairs, stadium seat cushions, and non-metal money clips

International Class(es): 020 - Primary Class

U.S Class(es): 002, 013, 014

Class Status: ACTIVE

Basis: 1(a)

First Use: 1970

Use in Commerce: 1970

For: Sport bottles sold empty, coasters, insulating sleeve holders for beverage cans, glass drinking glasses, earthenware mugs, and wastepaper baskets

International Class(es): 021 - Primary Class

U.S Class(es): 002, 013, 014

Class Status: ACTIVE

Basis: 1(a)**First Use:** 1970**Use in Commerce:** 1970**For:** Towels, bed blankets, cloth pennants, cloth flags, golf towels, and oven mitts**International Class(es):** 024 - Primary Class**U.S Class(es):** 042, 050**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** 1970**Use in Commerce:** 1970**For:** Clothing; namely, bandannas, t-shirts, shorts, sweaters, rain coats, sweatshirts, sweatpants, go socks, shoes university athletic team jerseys, belts and suspenders**International Class(es):** 025 - Primary Class**U.S Class(es):** 022, 039**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** 1970**Use in Commerce:** 1970**For:** Golf balls, golf bags, golf tees, divot repair tools, footballs, basketballs, [soccer balls, baseballs flying discs, stuffed toy animals, [and yo-yos]**International Class(es):** 028 - Primary Class**U.S Class(es):** 022, 023, 0**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** 1970**Use in Commerce:** 1970**Basis Information (Case Level)****Filed Use:** Yes**Currently Use:** Yes**Filed ITU:** No**Currently ITU:** No**Filed 44D:** No**Currently 44D:** No**Filed 44E:** No**Currently 44E:** No**Filed 66A:** No**Currently 66A:** No**Filed No Basis:** No**Currently No Basis:** No**Current Owner(s) Information****Owner Name:** University of South Carolina**Owner Address:** 109 Osborne Administration Building
Columbia, SOUTH CAROLINA 29208
UNITED STATES**Legal Entity Type:** STATE AGENCY**State or Country Where** SOUTH C
Organized:

Attorney/Correspondence Information**Attorney of Record****Attorney Name:** John C. McElwaine**Docket Number:** 13524/09C**Attorney Primary Email** ip@nelsonmullins.com**Attorney Email Authorized:** Yes**Address:****Correspondent****Correspondent** John C. McElwaine**Name/Address:** NELSON MULLINS RILEY & SCARBOROUGH LLP
100 North Tryon Street
42nd Floor, IP Department
CHARLOTTE, NORTH CAROLINA 28202
UNITED STATES**Phone:** (803) 799-2000**Fax:** (803) 255-**Correspondent e-mail:** ip@nelsonmullins.com**Correspondent e-mail** Yes
Authorized:**Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Sep. 12, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Sep. 12, 2012	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	77315
Sep. 12, 2012	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	77315
Sep. 11, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Aug. 27, 2012	TEAS SECTION 8 & 9 RECEIVED	
Nov. 30, 2009	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 09, 2009	REVIEW OF CORRESPONDENCE COMPLETE	65765
Mar. 30, 2009	RESPONSE RECEIVED TO POST REG. ACTION - SEC. 8	
Apr. 15, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	65765
Apr. 15, 2009	ASSIGNED TO PARALEGAL	65765
Mar. 30, 2009	RESPONSE RECEIVED TO POST REG. ACTION - SEC. 8 & 15	

Apr. 06, 2009	ASSIGNED TO PARALEGAL	66607
Apr. 01, 2009	REGISTERED - SEC. 8 (6-YR) FILED	
Apr. 01, 2009	PAPER RECEIVED	
Mar. 30, 2009	FAX RECEIVED	
Mar. 17, 2009	POST REGISTRATION ACTION MAILED - SEC. 8 & 15	65765
Jan. 13, 2009	ASSIGNED TO PARALEGAL	65765
Jan. 08, 2009	TEAS SECTION 8 & 15 RECEIVED	
Jan. 22, 2008	CASE FILE IN TICRS	
Jan. 14, 2003	REGISTERED-PRINCIPAL REGISTER	
Oct. 22, 2002	PUBLISHED FOR OPPOSITION	
Oct. 02, 2002	NOTICE OF PUBLICATION	
Aug. 10, 2002	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 06, 2002	EXAMINERS AMENDMENT MAILED	
Jul. 23, 2002	ASSIGNED TO EXAMINER	72152
Jul. 23, 2002	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
May 16, 2002	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 14, 2002	EXAMINERS AMENDMENT MAILED	
May 10, 2002	ASSIGNED TO EXAMINER	72152
May 10, 2002	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Oct. 30, 2001	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 03, 2001	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 08, 2001	NON-FINAL ACTION MAILED	
Feb. 20, 2001	ASSIGNED TO EXAMINER	72152

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jan. 14, 2013

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Sep. 12, 2

Assignment Abstract Of Title Information - None recorded

Proceedings - None recorded

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 2.101(b) and 2.119(4), the undersigned of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for the Opposer hereby certifies that I have served the Correspondent of Record of the above-referenced application listed with the United States Patent and Trademark Office TSDR database with a copy of the pleading(s) herein below specified by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings:

NOTICE OF OPPOSITION

Served:

PALMETTO PROMOTIONS LLC
PALMETTO PROMOTIONS LLC
1314 ROSEWOOD DR
COLUMBIA, SOUTH CAROLINA 29201-4706



4/16, 2014